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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,044	03/12/2004	Courtney W. Turpen	653.02	8581
7590 Geoffrey T. Staniford Dergosits & Noah LLP Suite 1450 Four Embarcadero Center San Francisco, CA 94111				
			EXAMINER	
			FETSUGA, ROBERT M	
			ART UNIT	PAPER NUMBER
			3751	
			MAIL DATE	DELIVERY MODE
			06/03/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,044

Applicant(s)

TURPEN, COURTNEY W.

Examiner

Robert M. Fetsuga

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3751

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 12, 2004 & August 31, 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The proposed drawing correction filed on April 09, 2008 is disapproved as containing new matter. The particular structure added to Fig. 3 (elements 325,330) is not described in the original specification. A detailed explanation of the changes made to the drawings could not be found in the response filed April 09, 2008.
2. The drawings are objected to because Fig. 3 is missing a legend (as amended August 31, 2006), and material cross-hatching is inaccurate in Fig. 4B.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin

as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim depends from a cancelled claim. For purposes of examination, claim 16 will be considered dependent from claim 9 in this Office action only.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-14 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb, Craig et al. and Price.

The Holcomb reference discloses a spa assembly comprising: a shell including a tub portion 12 and a flange 13; and plumbing elements including a suction component 19 and a return component 18. Re claim 1, the shell is capable of being fitted into an existing spa cavity as functionally recited at line 2, and in fact is supported in a gunite cavity 37. Re claim 4, the "vacuum-formed" recitation is a product-by-process limitation which does not serve to limit the product claim. Re claim 6, the shell is considered to be "readily insertable and removable" in the same sense as with applicant's disclosed invention. Re claim 9, the flange is capable of allowing masonry components to be laid thereon as functionally recited, and in fact appears to be contemplated by Holcomb in the sentence bridging columns 2 and 3. Re claim 10, no sandbags are disclosed by Holcomb. Therefore, Holcomb teaches all claimed elements except for the provisions of a spillway, a notch, operating controls, securing elements, and plumbing controls.

Although the shell of the Holcomb spa assembly does not include a spillway, as claimed, attention is directed to the Craig et al. (Craig) reference which discloses an analogous spa assembly which further includes a shell 18 having a spillway 50. Therefore, in consideration of Craig, it would have been obvious to one of ordinary skill in the spa assembly art to associate a spillway with the Holcomb shell in order to enable installation adjacent a swimming pool. Re claims 6 and 11, Craig further teaches constructing the spa assembly to be readily insertable and removable (col. 7 lns. 57-64) via twist-lock fasteners (col. 9 lns. 58-62). Re claim 12, the choice of fastener type would appear an obvious choice to be made.

Although the shell of the Holcomb spa assembly does not include a notch, as claimed, attention is directed to the Price reference which discloses an analogous spa assembly which further includes a shell 17 having a notch 67. Therefore, in consideration of Price, it would have been obvious to one of ordinary skill in the spa assembly art to associate a notch with the Holcomb shell in order to enable tile installation. Re claim 3, the choice of notch dimensions would appear an obvious choice to be made.

Although the Holcomb spa assembly does not include operating controls, as claimed, attention is again directed to

Craig which discloses operating controls C1. Therefore, in further consideration of Craig, it would have been obvious to one of ordinary skill in the spa assembly art to associate operating controls with the Holcomb spa assembly in order to facilitate operation. Re claim 21, Craig also teaches the claimed subject matter as previously acknowledged by applicant (pg. 9 of response filed August 31, 2006).

Applicant argues at pages 14-15 of the response filed April 09, 2008 the Holcomb, Craig and Price disclosures are not combinable because they are different systems. The examiner disagrees. Both Holcomb and Craig disclose spa assemblies. Craig further discloses combining a spa and a swimming pool in a smoothly integrated manner. Note column 4, line 20 through column 5, line 43 in Craig. This disclosure in Craig also appears consistent with the discussion at pages 1-4 in the instant specification. Given these facts, it is the examiner's opinion one skilled in the spa/swimming pool art would find ample motivation to smoothly integrate the Holcomb spa into a swimming pool by associating a spillway with the spa. Thus, a prima facie case of obviousness has been established. Applicant argues at page 15 of the response even if the Holcomb, Craig and Price disclosures were combined, the claimed invention would not result. The examiner disagrees. One skilled in the art would

find it desirable to integrate the spa shell 12 of Holcomb into a swimming pool as taught by Craig by associating a spillway with the spa shell because such would allow use of the swimming pool circulation system to serve both the spa shell and the swimming pool. Whether the spa shell is supported by an "X-brace concrete support system", or a gunite cavity, would not appear to affect the ability of the spa shell to cooperate with the swimming pool in the manner contemplated by Craig. As for the Price disclosure, it suffices to state that it is well-accepted practice to utilize a recess to secure tiles to a desired surface (col. 8 lns. 50-60).

6. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

7. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

/Robert M. Fetsuga/
Robert M. Fetsuga
Primary Examiner
Art Unit 3751